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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/694,839	10/29/2003	Yasushi Hattori	Q78107	2503
23373	7590	12/30/2005	EXAMINER	
SUGHRUE MION, PLLC 2100 PENNSYLVANIA AVENUE, N.W. SUITE 800 WASHINGTON, DC 20037			RICKMAN, HOLLY C	
			ART UNIT	PAPER NUMBER
			1773	

DATE MAILED: 12/30/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/694,839

Applicant(s)

HATTORI ET AL.

Examiner

Holly Rickman

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 10/7/05.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 2-10 and 13-22 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 2-10, 13-17, 20 and 22 is/are allowed.
- 6) ☒ Claim(s) 18, 19, 21 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Claim Rejections - 35 USC § 112***

1. The rejection of claims 5-10 under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement is withdrawn in view of Applicant's amendments.
2. The rejection of claims 2-10 and 13-17 under 35 U.S.C. 112, second paragraph, is withdrawn in view of Applicant's arguments and amendments.

### ***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. The rejection of claims 2-4 and 13-17 under 35 U.S.C. 103(a) as being unpatentable over Miyake et al. (US 5079096) in view of Kikitsu et al. (US 6602620) is withdrawn in view of Applicant's amendments and arguments.
5. Claims 18-19 and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Miyake et al. (US 5079096) in view of Kikitsu et al. (US 6602620).

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Miyake et al. disclose a magnetic recording medium comprising a magnetic particle containing layer on a nonmagnetic substrate with a layer of conductive polymer therebetween. The magnetic layer contains magnetic particles formed from a material such as Ba ferrite or Fe alloys and has a thickness of 80 nm (col. 11, lines 1-8; col. 11, line 48 to col. 13, line 32; col. 12, line 63 to col. 13, line 4). The reference is silent with respect to the use of CuAu or Cu<sub>3</sub>Au type ferromagnetic ordered phases, wherein a conductive layer formed from a conductive metal oxide or carbon black is provided on at least one side of the non-magnetic substrate.

With respect to the formation of a conductive layer, Miyake et al. teach that it is old in the art to use a conductive layer formed from an electrically conductive material such as carbon black (See col. 1, lines 44-51). Thus, it would have been obvious to one of ordinary skill in the art to use a carbon containing conductive layer instead of the inventive conductive polymer layer.

Kikitsu et al. disclose a magnetic recording medium having a magnetic recording layer containing magnetic particles selected from a group including Ba ferrite and ordered alloys such as FePt (i.e. CuAu type) (see col. 9, lines 45-62). Kikitsu et al. also teach the desirability of adding a layer on top of the magnetic recording film to serve as a protective layer (see col. 8, lines 57-64).

It would have been obvious to one of ordinary skill in the art at the time of invention to substitute an ordered CuAu type alloy such as FePt for the Ba ferrite particles taught by Miyake et al. in view of the art recognized equivalence of the two materials as shown by Kikitsu et al.

***Allowable Subject Matter***

6. The following is a statement of reasons for the indication of allowable subject matter: claims 2-10, 13-17, 20 and 22 are allowable over the closest prior art to Miyake et al. Miyake et al. fails to teach or suggest the claimed magnetic recording medium having a combination of CuAu-type or Cu<sub>3</sub>Au-type magnetic particles and a conductive layer having the claimed thickness containing one of the specified polymer materials.

***Response to Arguments***

7. Applicant's arguments filed 5/23/05 have been fully considered but they are not persuasive with regard to newly added claims 18-19 and 21.

8. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

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9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Holly Rickman whose telephone number is (571) 272-1514. The examiner can normally be reached on Monday-Friday 9:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Carol Chaney can be reached on (571) 272-1284. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Holly Rickman  
Primary Examiner  
Art Unit 1773